

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 since this Amendment: (a) places the application in condition for allowance for reasons discussed herein; (b) does not raise any new issue regarding further search and/or consideration since the Amendment amplifies issues previously discussed throughout prosecution; (c) does not present any additional claims without canceling a corresponding number of finally-rejected claims; and (d) places the application in better form for appeal, should an appeal be necessary. The Amendment is necessary because it is made in reply to arguments raised in the rejection. Entry of the Amendment is thus respectfully requested.

Summary of the Response

By the foregoing amendment, claims 2, 3 and 9 have been canceled and claims 4 and 8 have been amended. No new matter has been added. Claims 1 and 7 have been previously canceled. Thus, claims 4-6 and 8 are pending in the application and subject to examination.

In the Office Action mailed October 1, 2004, claims 2-6 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,268,242 to Williams, et al. in view of U.S. Patent No. 5,886,381 to Frisina. Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams, et al. in view of Frisina and U.S. Patent No. 4,963,970 to Throngnumchai, et al. It is noted that claims 4 and 8

have been amended and claims 2, 3 and 9 have been canceled. To the extent that the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections, as follows.

Claim 8 Recites Patentable Subject Matter

Applicants respectfully submit that nothing in the cited references, taken alone or in combination, discloses or suggests at least the feature of a closed “ring-shaped metal film [which] is a gate wiring which has gate connecting portions so as to connect to gate electrodes of said transistor cells with partial striding over said protective diode, and said gate connecting portions and source connecting portions of said source wiring which are contacted with said most inner layer are alternately formed in plan view,” as recited in claim 8, as amended.

With respect to the above-cited element of amended claim 8, which was previously incorporated in now canceled claim 3, the Office Action indicates that the ring-shaped metal film disclosed by the combination of Williams, et al. and Frisina, is gate wiring 712, which has gate connecting portions. However, the gate wiring 712 shown in Figure 7A of Williams, et al. is a tetragonal pad, as shown more clearly in Fig. 7B, and is not a “closed ring-shaped metal film,” as required by claim 8. Furthermore, gate wiring 712 does not have “connecting portions so as to connect to gate electrodes of said transistor cells with partial striding over said protective diode,” as also required by claim 8. In the present invention, the gate connecting portion of the gate wiring is shown, for example, as the portion directly connecting the ring-shaped metal wiring (gate wiring) to the gate electrode of a cell by going over the protective diode, as represented by reference numeral 2a in the embodiment shown in Figure 4. It is

respectfully submitted that Williams, et al. neither discloses nor suggests this element of the present invention.

Frisina fails to cure this deficiency in Williams, et al. Frisina teaches that connections to gate electrodes of cells are made by connecting at contact portion 44c by metal finger 44b. See Figure 6 and column 4, lines 42-44. Thus, neither Williams, et al. nor Frisina, taken alone or in combination, disclose or suggest the "connecting portions so as to connect to gate electrodes of said transistor cells with partial striding over said protective diode," as required by claim 8, as amended.

Furthermore, it is respectfully submitted that neither Williams, et al. nor Frisina, alone or in combination, disclose or suggest that "said gate connecting portions and source connecting portions of said source wiring which are contacted with said most inner layer are alternatively formed in plan view," as also required by amended claim 8. This element is indicated, for example, with reference numerals 2a and 3a in the embodiment shown in Figure 4 of the current application. Applicants respectfully submit that this element is neither disclosed nor suggested by Williams, et al. or Frisina, when taken alone or in combination.

With regard to the rejection of claim 8 under 35 U.S.C. §103(a) in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art

reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the stated motivation to combine Williams, et al. with Frisina is the "consequent improvement of the capability of the Zener diode." The Office Action further states that the inventions "can be combined . . . because the contact area . . . can easily be extended," and that the "success of the implementation of this combination can therefore be reasonably expected." See Office Action, at pages 4-5. It is respectfully submitted that this is an improper rejection based on hindsight, as the proposed motivation is not directed to the claimed differences, and the Examiner has not presented evidence in support of his position. There is nothing in either reference that would suggest a "closed ring-shaped metal film" with "connecting portions so as to connect to gate electrodes of said transistor cells with partial striding over said protective diode and said gate connecting portions and source connecting portions of said source wiring which are contacted with said most inner layer are alternatively formed in plan view," as described in detail above. Based on the above, the rejection is respectfully traversed.

For at least these reasons, Applicants respectfully submit that claim 8 is allowable over the cited art.

Claims 2-6 Recite Patentable Subject Matter

As claim 8 is allowable, Applicants respectfully submit that claims 4-6, each of which depends from allowable claim 8, are likewise allowable over the cited art.

Conclusion

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300, referring to client-matter number 107400-00044.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 107400-00044.

Respectfully submitted,

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Enclosure: Petition for Extension of Time (two months)

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